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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Royal Palm Miami Holdings LLC

Serial No.78351403

Lance D. Reich of Carlton Fields, P.A. for Royal Palm Miami Holdings LLC.

Alex Seong Keam, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Seeherman, Quinn and Drost, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Royal Palm Miami Holdings LLC has applied to register
PARAMOUNT as a mark for the following services, as amended:

Real estate brokerage services of
residential real estate, in Class 36;
and

Land development services, namely
planning and laying out of residential

condominiums and communities, in Class
37.¹

The Examining Attorney issued a final refusal of registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the marks shown below, registered to different entities, that, if used in connection with applicant's services, it is likely to cause confusion or mistake or to deceive.

Registration No. 2685613, owned by Paramount Group, Inc., is for the mark PARAMOUNT GROUP, INC. and design, with GROUP, INC. disclaimed, for "business management; business consultation; bookkeeping and income tax preparation; and business services, namely facilities management of technical operations" (Class 35) and "leasing of office space; real estate management" (Class 36).²

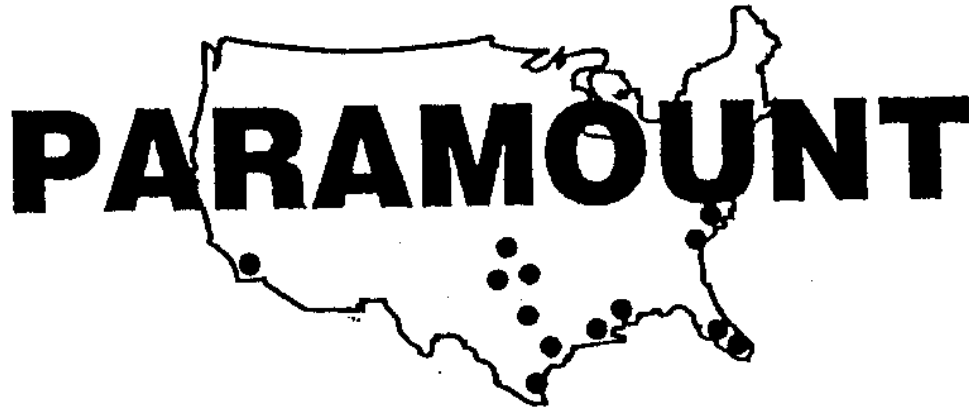


Registration No. 2008337, owned by West Coast Paramount Construction, Inc., is for the mark PARAMOUNT and

¹ Application Serial No. 78351403, filed January 13, 2004, asserting first use and first use in interstate commerce on May 2, 1999.

² Issued February 11, 2003.

map design, with a disclaimer of "the representation of the outline of the contiguous states of the United States," for "building construction, repair and renovation" (Class 37).³



Applicant has appealed the refusal of registration. Applicant and the Examining Attorney filed briefs; applicant did not request an oral hearing.

Before turning to the substantive issue of likelihood of confusion, we must address a procedural point. With its request for reconsideration, applicant submitted a list of third-party applications and registrations. The Examining Attorney denied the request, and pointed out that submitting a mere list of applications and registrations is not sufficient to make them of record. Applicant then filed its notice of appeal and, subsequently, its appeal brief. With its appeal brief applicant submitted copies of

³ Issued October 15, 1996; Section 8 & 15 affidavits accepted and acknowledged.

some third-party registrations for PARAMOUNT marks. The Examining Attorney has objected to these registrations as untimely. The objection is well taken. Trademark Rule 2.142(d) provides that the record in the appeal should be complete prior to the time the appeal is filed. Accordingly, we have given these registrations no consideration.⁴ For the same reason, we have not considered the web pages from the Certified Commercial Investment Member Institute and the Council of Residential Specialists, also submitted for the first time with applicant's appeal brief.

This brings us to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood

⁴ Even if the registrations had properly been made of record, the services listed therein are financial and insurance services. Therefore, they do not show that PARAMOUNT has a particular significance in the real estate brokerage/management/building construction field. Moreover, third-party registrations are not evidence that the marks shown therein are in use. See *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them").

of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We will discuss the cited registrations separately.

Registration No. 2685613 is for PARAMOUNT GROUP, INC. and design. Although this registration is for services in two classes, it is clear that registration has been refused on the basis applicant's mark is likely to cause confusion with the registrant's mark for the services of real estate management and leasing of office space.

It is not necessary that the goods and/or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding their marketing are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *In re International Telephone &*

Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). In order to demonstrate the relatedness of applicant's real estate brokerage services of residential real estate in Class 36 and the registrant's services of real estate management and leasing of office space, the Examining Attorney has submitted numerous third-party registrations listing services of the type identified in applicant's application and the cited registration. See, for example, Registration No. 2819065 for, inter alia, real estate brokerage and for real estate management for real estate featuring single family, multi-family and adult congregate care residential facilities; Registration No. 2883648 for, inter alia, real estate brokerage and leasing of real estate; and Registration No. 2819492 for, inter alia, leasing of real estate, real estate management, and real estate brokerage related to condominiums and co-ops, town houses, homes, commercial space, apartments and office space. With respect to applicant's land development services of planning and laying out residential condominiums and communities in Class 37, the Examining Attorney has submitted such third-party registrations as No. 2819492 for, inter alia, real estate management related to condominiums and co-ops, town houses, homes, commercial space, apartments and office space, and real estate

development services related to condominiums and co-ops, town houses, homes, commercial space, apartments and office space; No. 2850589 for, inter alia, real estate management and for building construction and development services, namely real estate development and building repair and maintenance services; Registration No. 2915091 for, inter alia, real estate management of... residential facilities and for development in the nature of planning and laying out of ... residential facilities; and Registration No. 2856000 for, inter alia, real estate management services and for real estate and land development services. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant has asserted that its services differ from those of the registrant, in that its services are limited to real estate brokerage services of residential real estate, while the services in the cited registration are for commercial real estate. However, this is a misreading of the identification in the cited registration. Although one of the services listed in the registration is "leasing of office space," the identification also includes "real

estate management," and there is no limitation for these services. Where the goods [or services] in a cited registration are broadly described and there are no limitations in the identification of goods [or services] as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods [or services] of the nature and type described, that the identified goods [or services] move in all channels of trade that would be normal for such goods [or services], and that the goods [or services] would be purchased by all potential customers. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Therefore, the registrant's identification is deemed to include management of residential real estate.

A consumer who rents a home or apartment is likely to have contact with the management for that residential real estate and, when ready to purchase a home, may use the services of a real estate broker. Thus, they may encounter both services. Similarly, if that consumer decides to purchase a home in a residential community, he is likely to encounter a mark used in connection with the planning and laying out of the residential community or condominium building.

Because the evidence shows that both applicant's and the registrant's services may emanate from a single source, and because consumers may be exposed to both types of services and the marks used therefor, the services are related, and the du Pont factor of the similarity of the services favors a finding of likelihood of confusion. Moreover, since both services, as identified, may be offered to residential real estate buyers and owners, the services are offered in the same channels of trade, and this, too, favors a finding of likelihood of confusion.

This brings us to a consideration of the marks. Applicant has applied to register PARAMOUNT in standard character form; thus, it is not relying on any particular stylization for the mark. The cited mark is for the words PARAMOUNT GROUP, INC., along with a triangle design to the left of these words. In comparing the marks, we find that PARAMOUNT is the dominant element of the cited mark, and accordingly deserves more weight in our analysis. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their

entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In the registrant's mark, the triangle design is both visually smaller than the words, and is not easily articulated. If a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). As for the word portion, the words GROUP and INC. (which have been disclaimed) have virtually no source-indicating value. For these reasons, we consider PARAMOUNT to be the dominant feature of the registered mark. We further find that, when the marks are compared in their entireties, they are extremely similar in appearance, pronunciation, connotation and commercial impression. Put another way, the fact that applicant's mark does not contain the additional elements in the registered mark does not serve to distinguish applicant's mark from that of the registrant. Consumers who are familiar with the registrant's mark are likely to view applicant's mark as merely a shortened version of the registered mark, indicating services emanating from the same source.

We have considered applicant's argument that the PARAMOUNT portion of the cited mark is weak, and therefore

entitled to less weight when the marks are compared. As noted previously, the copies of third-party registrations submitted by applicant with its brief are untimely and have not been considered, while the list of marks submitted with applicant's request for reconsideration have no probative value. Thus, the only registrations for PARAMOUNT marks that are of record are the two registrations which have been cited against the registration of applicant's mark. The presence of two co-existing registrations in the real estate field hardly demonstrates that PARAMOUNT is a weak term in this area. Further, as "to strength of a mark, however, registration evidence may not be given any weight." Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original). While the word paramount means "of chief concern or importance; primary; foremost" and "supreme in rank, power, or authority,"⁵ and therefore has a somewhat laudatory suggestion, it is certainly not so highly suggestive that we would regard it as a weak term. Because the other elements in the cited mark have little or no source-indicating significance, consumers will look to

⁵ The American Heritage Dictionary of the English Language, © 1970. The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

PARAMOUNT, and not to these other elements, to distinguish the source of the registrant's services.

The factor of the similarity of the marks favors a finding of likelihood of confusion.

There has been no discussion of the remaining du Pont factors. To the extent that any are applicable, they must be considered to be neutral. In this connection, with respect to the factor of the conditions of purchase, the consumers can include members of the general public, who would not be considered particularly sophisticated. While decisions regarding the purchase of housing would not be made on impulse, and therefore consumers may note the specific differences between the marks, they are not likely to view these differences as indicating different sources of the sources because the marks will be regarded as variants of each other.

Accordingly, after considering all of the relevant du Pont factors, we find that the use of applicant's mark for its identified services in both classes 36 and 37 is likely to cause confusion with Registration No. 2685613.

We turn next to the refusal of registration based on Registration No. 2008337 for PARAMOUNT and map design for "building construction, repair and renovation." Again, the Examining Attorney has submitted third-party registrations

which show the relatedness of these services with applicant's identified real estate brokerage services and land development services. For registrations that include both real estate brokerage services of residential real estate, and building construction, repair and renovation, see, for example, Registration No. 2856000 for, inter alia, real estate brokerage services and residential, commercial and industrial building construction and repair services; Registration No. 2874723 for, inter alia, real estate brokerage services and residential and commercial building construction; and Registration No. 2185421 for, inter alia, leasing, brokerage and management of real estate, all with respect to ... commercial, retail and residential developments, and planning, developing and constructing business and industrial buildings, commercial, retail and residential developments. As for third-party registrations listing both land development services and building construction, repair and renovation see, for example, Registration No. 2877384 for, inter alia, land development services namely, planning and laying out of residential communities and building construction and repair; Registration No. 2923337 for, inter alia, building construction and development—residential and commercial, and planning, laying out and custom construction of

residential communities; and Registration No. 2929552 for, inter alia, land development services, namely planning and laying out of residential and commercial communities, and residential and commercial building construction and repair. Again, these registrations tend to show that the services identified in applicant's application and those listed in Registration No.2008337 can emanate from a single source and be offered under a single mark.

Such services can also be offered to the same class of consumers, namely members of the public at large who own or wish to build a home. A consumer can use a real estate broker's services to buy or sell a home or a lot for a home, and might also use the registrant's services to build a home, or repair or renovate one. Or someone who has built or renovated a home using the registrant's services and who is later interested in living in a planned community might encounter applicant's mark and, because the third-party registrations show that construction services and land development services can emanate from a single source under a single mark, that consumer may well think, if the services are offered under the same or confusingly similar marks, that the services are sponsored by or are affiliated with the same source.

Accordingly, we find that the services are related, and that they can be offered to the same classes of consumers. The du Pont factors of the similarity of the services and the channels of trade therefore favor a finding of likelihood of confusion.

The mark in Registration No. 2008337 is the word PARAMOUNT, shown in large bold letters superimposed on an outline of the United States. As noted above, when a mark consists of a word and design, it is normally the word portion that is the dominant element, and the registered mark is no exception. The fact that the word PARAMOUNT will be spoken, and its prominent appearance in the mark, entitles it to greater weight when comparing the marks. This word is, of course, identical to applicant's mark, and the additional design element is not enough to distinguish the marks. Consumers are likely to view PARAMOUNT and PARAMOUNT and map design as variant marks indicating services emanating from a single source.

Because of the prominent depiction of PARAMOUNT in the cited mark, the marks are similar in appearance and identical in pronunciation. They are also virtually identical in connotation in view of the common element PARAMOUNT. While the design element in the registrant's mark suggests that the services are offered in the United

States, or perhaps in the specific places on which dots appear on the map, this additional suggestion does not change the primary connotation of the mark as being the word PARAMOUNT. We also find that the marks convey similar commercial impressions. Thus, the factor of the similarity of the marks favors a finding of likelihood of confusion.

We have previously discussed applicant's argument that the registrant's mark is weak, and need not do so again.

As with the refusal based on Registration No. 2685613, there has been no discussion of the remaining du Pont factors. To the extent that any are applicable, they must be considered to be neutral. This would include the factor of the conditions of purchase; our comments with respect to Registration No. 2685613 apply here as well.

Having considered all the applicable du Pont factors, we find that applicant's mark for its identified services in both Class 36 and Class 37 is likely to cause confusion with Registration No. 2685713.

Decision: The refusal to register applicant's mark is affirmed with respect to the application in both Class 36 and Class 37 on the ground of likelihood of confusion with both of the cited registrations.